

ESTTA Tracking number: **ESTTA122088**

Filing date: **01/29/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91174972
Party	Plaintiff SolidWorks Corporation SolidWorks Corporation ,
Correspondence Address	Charles E. Weinstein, Esq. Foley Hoag LLP 155 Seaport Boulevard Boston, MA 02210-2600 UNITED STATES cew@foleyhoag.com, mboudett@foleyhoag.com, mpogach@foleyhoag.com, gmaclellan@foleyhoag.com
Submission	Motion to Consolidate
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Date	01/29/2007
Attachments	Motion To Consolidate and Set Accelerated Sched for Discovery and Testimony Periods.pdf ( 16 pages )(554109 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

Opposer/Petitioner,

v.

SOLIDWORKS, CORPORATION,

Applicant/Respondent.

Consolidated Opposition No. 91170857;  
Cancellation No. 92046253

Marks: DWGGATEWAY (Application Serial  
No. 78651780), DWGEDITOR (Registration  
No. 3,134,536)

SOLIDWORKS CORPORATION,

Opposer,

v.

AUTODESK, INC.,

Applicant.

Opposition No.  
91174972

Application Serial No.  
78852849

Mark: DWGX

SOLIDWORKS CORPORATION,

Opposer,

v.

AUTODESK, INC.,

Applicant.

Opposition No.  
91175197

Application Serial No.  
78852836

Mark: REALDWG

SOLIDWORKS' MOTION TO CONSOLIDATE AND TO SET ACCELERATED  
SCHEDULE FOR DISCOVERY AND TESTIMONY PERIODS

Pursuant to Rule 42(a), Fed. R. Civ. P. and TBMP § 511, Opposer SolidWorks Corporation moves for an order consolidating Opposition Nos. 91174972 and 91175197 with the consolidated proceedings, Opposition No. 91170857 and Cancellation No. 92046253, captioned *Autodesk, Inc. v. SolidWorks Corporation*, and setting an accelerated schedule for all

consolidated actions. At this relatively early period, consolidation on an accelerated schedule is the far more efficient and logical approach compared to suspension of Opposition Nos. 91174972 and 91175197 pending resolution of the consolidated proceeding, as sought by Autodesk.

**A. History of the Dispute**

SolidWorks is the owner of Application Serial No. 78651780 for the mark DWGGATEWAY and Registration No. 3134536 for the mark DWGEDITOR, both used in connection with its computer software for computer-aided design. Both applications were filed on June 16, 2005 and claim priority to Autodesk's applications for REALDWG (Application Serial No. 78852836) and DWGX (Application Serial No. 78852849).

Autodesk has opposed Application Serial No. 78651780 for the mark DWGGATEWAY (Opposition No. 91170857) and has petitioned to cancel Registration No. 3134536 for the mark DWGEDITOR (Cancellation No. 92046253). Both the notice of opposition and the petition for cancellation are based on Autodesk's assertion of some form of prior rights to the term "DWG" and claim that SolidWorks' marks are confusingly similar to that term. In its answers, SolidWorks raised affirmative defenses that the term DWG is generic and that to the extent either party has rights in marks incorporating DWG, SolidWorks has priority. On November 4, 2006, the Board granted SolidWorks' consented to motion for consolidation of these proceedings (hereinafter the "Consolidated Proceedings"). Around this time, lead counsel for SolidWorks, John Welch, left Foley Hoag to practice at another law firm. Declaration of Miriam L. Pogach ("Pogach Decl."), ¶ 2. The parties did not exchange documents responsive to the first set of document requests until just over a month ago, December 20, 2006. *Id.* Exs. A, B. Neither party has noticed a deposition nor have any depositions been taken. *Id.* ¶ 5.

In the meantime, Autodesk's applications to register the marks DWGX and REALDWG, Application Serial No. 78852849 and Application Serial No. 78852836 respectively, were published in the *Official Gazette*. SolidWorks opposed these applications on January 5, 2007 and January 18, 2007, Opposition Nos. 91174972 and 91175197, based on its prior rights in DWGGATEWAY and DWGEDITOR. In its answers to these notices of opposition, Autodesk asserted superior rights to "DWG" as an affirmative defense. On January 22, 2007, Autodesk moved to suspend Opposition Nos. 91174972 and 91175197, requesting that the Board delay those matters pending resolution of the consolidated proceeding. SolidWorks opposes Autodesk's motion for suspension in favor of consolidating the three proceedings as requested by the instant motion.

#### **B. Discussion**

The Board may consolidate multiple actions where the actions involve common questions of fact and law. Fed. R. Civ. P. 42(a); TBMP § 511. In determining whether to consolidate cases, the Board weighs the savings in time, effort and expense which may be gained from consolidation against any prejudice or inconvenience which may be caused thereby. TBMP § 511.

All of the proceedings at issue here involve common questions of fact and law because determination of the parties' respective rights hinge on the same questions: whether Autodesk has any rights to the phrase "DWG" and if so, whether those rights are prior to those of SolidWorks. Furthermore, the proceedings all involve the same parties, closely related marks and identical or closely related goods, as all of the applications in question seek to register marks incorporating the term "DWG" used in connection with computer software for computer-aided design and manufacturing. The registration in question likewise pertains to a mark incorporating

DWG for use in connection with computer software for computer-aided design and manufacturing. Autodesk similarly recognizes in its Motion for Suspension that the key issues to be determined in both the Oppositions to DWGX and REALDWG and the Consolidated Proceeding are “(i) whether the term ‘DWG’ is generic; and (ii) if not, whether [Autodesk] or [SolidWorks] has trademark priority.” (Autodesk’s Motion for Suspension of Proceedings, at 5.) Consequently, whether consolidation or suspension is preferable depends on which course of action is the most logical and efficient.

Here, consolidation is the prudent option over suspension because virtually all the evidence at trial will likely be the same in each separate proceeding given the similarity of the marks and the goods at issue, and the identical legal arguments. The evidence that will support SolidWorks’ arguments in its Oppositions to DWGX and REALDWG is identical to the evidence that will support its affirmative defenses in the Consolidated Proceeding. Likewise, Autodesk will use the same evidence in support of its assertion of prior rights in DWG in the Consolidated Proceeding as will use to support its affirmative defenses in the Oppositions to DWGX and REALDWG.

Thus, if these cases are not consolidated, the parties will have to take and enter repetitive testimony and evidence in separate cases, file repetitive sets of briefs, and prepare for and attend separate hearings on similar issues. Consequently, the Board would have to waste its efforts reviewing the same record, reading repetitive briefs and preparing for duplicative hearings. This is true whether the oppositions to DWGX and REALDWG proceed in accordance with their current schedules or whether they are suspended until a later date as Autodesk requests in its motion for suspension. On the other hand, consolidation of the cases would result in a significant savings of time and expense for both parties, since each party would be taking and

entering testimony only once, filing only one set of briefs, and preparing for and attending only one hearing. Consolidation would therefore prevent a wasteful duplication of effort and would render benefits to the Board in terms of judicial economy.

In its Motion for Suspension of SolidWorks' oppositions to DWGX and REALDWG, Autodesk speculates that resolution of the Consolidated Proceeding would narrow the issues in those oppositions and in future DWG-related proceedings between the parties, but this is far from evident. It is entirely possible for the Consolidated Proceeding to be resolved on SolidWorks' affirmative defenses of laches, acquiescence or estoppel, which would have no bearing on the Oppositions to DWGX and REALDWG, or any future proceeding in which the parties respective rights to DWG are at issue.<sup>1</sup> This would leave the parties and the Board back at square one in the recently filed oppositions by SolidWorks, which would not have progressed in the meantime. On the other hand, consolidation of the oppositions with the Consolidated Proceeding provides the Board with a more complete picture of the parties' dispute, will lead to a more comprehensive resolution at an earlier time, and is a far superior alternative to Autodesk's piecemeal suggestion.

Furthermore, neither party will be prejudiced by consolidation of SolidWorks' Oppositions with the Consolidated Proceeding. SolidWorks opposed Autodesk's applications for DWGX and REALDWG before the close of the discovery period in the Consolidated Proceeding, hoping to consolidate all of the matters so as to resolve multiple facets of this dispute at the same time. Discovery is in its early stages in the Consolidated Proceeding, no

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<sup>1</sup> These defenses raise serious issues and could well be the independent basis for a decision, given Autodesk's affirmative disclaimers of trademark rights in DWG for many years and SolidWorks' reliance on Autodesk's words and conduct in selecting its own marks containing this functional letter string.

depositions having been taken. Pogach Decl., ¶ 5. As discussed below, the accelerated schedule proposed herein results in only a two-month extension of the current deadline in the Consolidated Proceeding.<sup>2</sup>

In its motion for suspension, Autodesk complains that SolidWorks could “put off a determination regarding [Autodesk’s] use of DWG-based marks for years” by planning to oppose Autodesk’s applications to register DWG, DWG AND DESIGN, TRUSTEDDWG, DWG TRUEVIEW, DWG TRUECONVERT, and DWG EXTREME. (Autodesk’s Motion for Suspension of Proceedings, at 4.) However, Autodesk’s application for the mark DWG has been rejected and the Examining Attorney has sent an office action to Autodesk requiring a disclaimer of DWG in its applications for DWG AND DESIGN, DWG TRUEVIEW, DWG TRUECONVERT, and DWG EXTREME. At this point, Autodesk has not responded to those office actions nor has it appealed the Board’s rejection. Although SolidWorks will likely oppose Autodesk’s DWG related applications in the event that they achieve publication, SolidWorks has no intent to delay the current proceedings based on proceedings that are not yet possible. Alternatively, the temporal proximity of the instant oppositions to the consolidated proceeding warrants consolidation instead of suspension, especially given the efficiency gained in resolving multiple aspects of this dispute at once.<sup>3</sup>

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<sup>2</sup> Indeed, even if the instant motion to consolidate is denied, SolidWorks anticipates that given the state of discovery and the rapidly-approaching deadline, it will have to move for an extension of the discovery period in the Consolidated Proceeding any event, whether by agreement or otherwise.

<sup>3</sup> To the extent that Autodesk is concerned that SolidWorks will move to consolidate future oppositions to Autodesk’s DWG-related applications for purposes of delay, SolidWorks is willing to stipulate, should the Board grant this Motion to Consolidate, that any such future oppositions either will not be consolidated with these proceedings or will not delay the below-proposed schedule, absent agreement of both parties.

Since discovery has not yet closed in any of the Board proceedings at issue here, SolidWorks submits that consolidation and an accelerated schedule for discovery as suggested below provide for the most sensible resolution of these matters. Autodesk cannot legitimately claim that a two month extension of the close of the discovery and testimony periods constitutes prejudice by “eleventh-hour delay” when documents were only first produced slightly over a month ago, on a date agreed upon by both parties. Pogach Decl., Exs. A, B. This is especially true considering that Autodesk previously requested an extension to respond to SolidWorks’ discovery requests, which SolidWorks granted. Irrespectively, the savings in time, effort and expense that would be gained by consolidation of the oppositions to DWGX and REALDWG with the consolidated proceeding far outweigh any alleged prejudice to Autodesk.

SolidWorks proposes an expedited discovery schedule should the Board consolidate the proceedings at issue, as much of the discovery already served in the consolidated proceeding relates to SolidWorks oppositions to DWGX and REALDWG. This is particularly fair given SolidWorks’ change in counsel in November. Should the Board grant SolidWorks’ motion to consolidate, SolidWorks proposes dates for the close of discovery and testimony periods as follows:

Discovery Period to close:	April 28, 2007
Testimony period for party in position of plaintiff to close (opening thirty days prior thereto)	July 24, 2007
Testimony period for party in position of defendant to close (opening thirty days prior thereto)	September 23, 2007
Rebuttal testimony period to close (opening 15 days prior thereto)	November 7, 2007

These various deadlines extend the existing deadlines in the Consolidated Proceeding by only

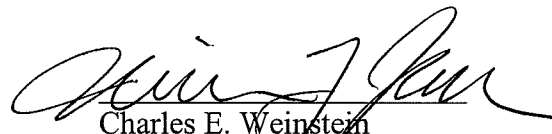


two months.

Suspension, available at the Board's discretion, is most commonly used to suspend Board proceedings pending resolution of a related civil action between the parties. TBMP § 510. Here, the Board has the option to consolidate the proceedings in question to allow as much of the parties' DWG-related dispute as possible to go forward in a reasonable time frame. As discussed above, the efficiencies gained in resolving those aspects of the parties' dispute that are currently ripe for decision clearly outweigh any alleged prejudice that Autodesk might claim to suffer from a two month extension of the discovery period. SolidWorks therefore respectfully requests that the Board grant its motion to consolidate and reset the dates for the discovery and trial periods as proposed in this motion.

Respectfully submitted,

SOLIDWORKS CORPORATION

A handwritten signature in dark ink, appearing to read "Charles E. Weinstein", is written over the printed name.

Charles E. Weinstein  
Michael P. Boudett  
Miriam L. Pogach  
Foley Hoag LLP  
155 Seaport Blvd.  
Boston, MA 02210  
(617) 832-1000

Dated: January 29, 2007

CERTIFICATE OF SERVICE

I hereby certify that a true copy of SolidWorks Motion to Consolidate and to Set Accelerated Schedule for Discovery and Testimony Periods, and the supporting Declaration of Miriam L. Pogach were served on upon

John Slafsky  
Brian Mendonca  
Wilson Sonsini Goodrich & Rosati PC  
650 Page Mill Road  
Palo Alto, CA 94304

by first class mail on this date of January 29, 2007.

  
Geraldine MacLellan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

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78852849

Mark: DWGX

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AUTODESK, INC.,

Applicant.

Opposition No.  
91175197

Application Serial No.  
78852836

Mark: REALDWG

DECLARATION OF MIRIAM L. POGACH  
IN SUPPORT OF SOLIDWORKS' MOTION TO CONSOLIDATE AND TO SET  
ACCELERATED SCHEDULE FOR DISCOVERY AND TESTIMONY PERIODS

I, Miriam L. Pogach, declare:

1. I am an attorney at law licensed to practice in the Commonwealth of Massachusetts. I am associated with the law firm of Foley Hoag LLP, counsel of record for SolidWorks Corporation. I make this declaration based on personal knowledge of the following facts.

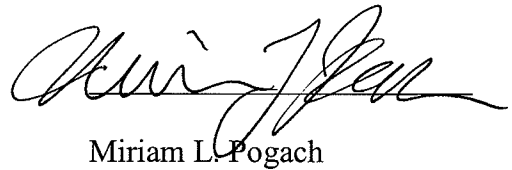
2. On or about November 1, 2006, John Welch, Esq. left his employment as counsel at Foley Hoag LLP. He is currently employed at Lowrie, Lando & Anastasi, LLP in Cambridge, Massachusetts. Up until his departure, Attorney Welch handled Opposition No. 91170857 (regarding DWGGATEWAY) and Cancellation No. 92046253 (regarding DWGEDITOR) on behalf of SolidWorks. Neither myself nor Michael Boudett, a partner at Foley Hoag, had any involvement in these proceedings until approximately a week and a half following Attorney Welch's departure.

3. Exhibit A is a true and accurate copy of a letter dated December 20, 2006 that I sent to counsel for Autodesk enclosing documents that SolidWorks produced in response to Autodesk's First Request for Production of Documents and Things.

4. Exhibit B is a true and accurate copy of a letter dated December 20, 2006, received by counsel for SolidWorks from Brian Mendonca enclosing documents that Autodesk produced in response to SolidWorks' Requests for the Production of Documents and Things.

5. As of January 29, 2007, the date of this declaration, SolidWorks has neither noticed nor taken any depositions in Opposition No. 91170857 or Cancellation No. 92046253. As of this date, counsel for SolidWorks has not been served with any notices of depositions by counsel for Autodesk nor has Autodesk taken any depositions in either of those proceedings.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. This declaration was executed on January 29, 2007.



Miriam L. Fogach

# EXHIBIT A



**FOLEY  
HOAG** LLP  
ATTORNEYS AT LAW

December 20, 2006

Miriam Pogach  
Boston Office  
617.832.3025

John Slafsky  
Wilson Sonsini Goodrich & Rosati PC  
650 Page Mill Road  
Palo Alto, CA 94304-1050

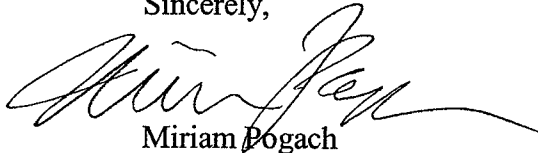
Re: Autodesk v. SolidWorks: TTAB Nos. 91170857, 92046253

Dear John:

Enclosed for production in the above-mentioned proceedings, please find documents bearing Bates numbers SD-000001 through SD-000704. These documents have been produced in response to Autodesk's First Request for Production of Documents and Things to SolidWorks.

Several of these documents are marked "confidential" or "commercially sensitive" in accordance with Provision (1) of the Protective Order between the parties. Thus, they are to be treated in accordance with the guidelines set forth in the Protective Order.

Sincerely,



Miriam Pogach

cc: Mike Boudett

B3295058.1

# EXHIBIT B



December 20, 2006

**Via Overnight Delivery**

Michael P. Boudett  
Miriam L. Pogach  
Foley Hoag, LLP  
Seaport World Trade Center West  
155 Seaport Boulevard  
Boston, Massachusetts 02210-2600

***Re: Autodesk v. SolidWorks (TTAB No. 91170857)***


Dear Michael and Miriam:

Enclosed please find Autodesk's first production of documents in response to SolidWorks' Requests for the Production of Documents and Things. The enclosed documents are numbered A000001-A009101. Please note that many of the documents in Autodesk's production have been designated "trade secret/commercially sensitive" pursuant to the Protective Order in this matter and should be treated accordingly.

Our investigation in this matter is ongoing, and we will promptly produce any additional responsive documents we discover.

Very truly yours,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

  
Brian G. Mendonca